

REMARKS

Claims 1 and 4, 5, 7, 8, 10, 11, 13, 14, 16, 17, 19 and 20 are pending. No new matter has been added by way of the present amendments. For instance, "adhesive" claims 1, 6, 9, 12, 15, 18 and 21 have been cancelled. Also, the remaining claims have been amended to remove reference to the identifiers "first" and "second." Further, the specification has been amended to correct a minor typographical error and to correct the point of attachment of R^4 in formula (2), which was an amendment already accepted by the Examiner. Accordingly, no new matter has been added.

Additionally, Applicants submit that no new issues have been raised by way of the present submission which would require additional search and/or consideration on the part of the Examiner. Claims have been either cancelled or clarified herein. This does not present the Examiner with an additional burden of search and/or consideration. Therefore, no new issues have been raised.

Further, in the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Clarification concerning USPTO Printing Errors in Publication

The present application has published as US 2002-0127360 A1. Although the period for correction of the publication is past, Applicants take this opportunity to request that any

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ultimately issuing patent not include printing errors on the part of the PTO. For instance, [0047] of the publication, which corresponds to the paragraph at page 18, line 17 to page 19, line 10 of the specification as originally filed should recite "at an angle of 65°" and not "at an angle of 650." Further, in Table 5, sixth column, the word "discoloration" of page 30 as originally filed has been misprinted in the publication as "diacoloration". Since "amendments to the specification" should be directed to the originally filed application, and the originally filed application does not require correction in the above two issues, Applicants simply bring this matter to the attention of the USPTO in the hope that any ultimately issuing patent does duplicate these publication errors.

Issues Under 35 U.S.C. §112, first paragraph

The Examiner has rejected claims 1-21 under 35 U.S.C. §112, first paragraph for the reasons recited at page 3 of the outstanding Office Action.¹ Applicants respectfully traverse.

The Examiner asserts that the recitation of "first" fluorine-containing polymer and "second" fluorine-containing polymer, introduces "new matter" into the claims. That is, the Examiner asserts that the specification does not contain a description such as to reasonably convey to one of skill in the art that the inventors possessed the claimed subject matter at the time of filing. Applicants respectfully disagree with the Examiner.

The designation of "first" and "second" fluorine-containing polymers was employed to avoid confusion between (1) the fluorine-containing polymer in the pellicle film, and (2) the

¹ Although the Examiner has rejected claims 1-21, Applicants point out that, based upon the April 6, 2005 Amendment indicated as entered by the Examiner, claims 1 and 4-21 were pending at the time of issuance of the outstanding Office Action.

fluorine-containing polymer in the adhesive. As such, even though there is no verbatim support for “first” and “second” in the specification, such support is implicit. Further, one of ordinary skill in the art would fully understand that Applicants were in possession of the subject matter at the time of filing.

However, to expedite prosecution, Applicants have removed the “first” and “second” designations from the claims. Thus, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

Issues under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-21 under 35 U.S.C. §103(a) as being obvious over Yamamoto *et al.*, JP 63-248807 (hereinafter referred to as Yamamoto), in view of Yagi *et al.*, JP 03-163182 (hereinafter referred to as Yagi) and Yutaka *et al.*, JP 04-028772 (hereinafter referred to as Yutaka).² Applicants respectfully traverse this rejection.

There exists no *prima facie* case of obviousness

The primary reference of Yamamoto is cited as disclosing a fluorine-containing polymer utilized in an adhesive composition for optical instruments. The Examiner has supplemented the disclosure of Yamamoto with that of Yagi and Yutaka. The Examiner cites Yagi as showing that adhesives comprising fluorinated polymers and fluorinated monomers are known. The disclosure of Yutaka is utilized by the Examiner as disclosing the specific ultraviolet-curing fluorine-containing monomers according to the present invention. However, Applicants

² As indicated above, claims 1 and 4-21 were pending at the time of issuance of the outstanding Office Action.

respectfully submit that the secondary references of Yagi and Yutaka are non-analogous art as they do not disclose utilization of adhesives for optical instruments. Therefore, one of skill in the art would be provided with no motivation to modify the teachings of Yamamoto with the disclosures of either Yagi or Yutaka.

At most the Examiner's rejection amounts to an "obvious to try" standard, which is improper in the presentation of a *prima facie* case of obviousness. "Obvious to try" is not a valid test of patentability. In re Mercier, 185 USPQ 774 (CCPA 1975); see also Hybritech Inc. v. Monoclonal Antibodies, 231 USPQ 81 (Fed. Cir. 1986). See also Ex parte Argabright et al., 161 U.S.P.Q. 703 (POBA 1967) (obviousness must be predicted on something more than it would be obvious "to try" the particular class of solvent recited in the claims or the possibility it will be considered in the future, having been neglected in the past).

However, this is exactly what the Examiner is contending. The Examiner simply submits that it would be obvious to try the compounds of the secondary references in the system of Yamamoto simply because all references deal with polymers. This is "obvious to try" and cannot provide the requisite motivation for a proper *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion of incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987).

The Examiner has attempted to argue that all references are analogous art since they come from the same field of endeavor regarding adhesives. However, the presently pending claims relate to a pellicle (see claims 4, 7, 10, 13, 16 and 19) and to a method for producing a

pellicle (see claims 5, 8, 11, 14, 17 and 20), not to an adhesive. Therefore, the relevant field to those of skill in the art is not simply “adhesives” as asserted by the Examiner.

In summary, due to the lack of motivation to combine the cited references, Applicants submit that there exists no *prima facie* case of obviousness. Thus, this rejection is improper and should be withdrawn. Moreover, even if the Examiner has hypothetically established a *prima facie* case of obviousness, a point not conceded by Applicants, the presently claimed subject matter achieves unexpectedly superior results. Thus, any hypothetical *prima facie* case of obviousness is moot.

Unexpected and Superior Results Exist.

Applicants respectfully submit that unexpectedly superior results are achieved by the present invention. The pellicle and production method according to the present invention are particularly suitable for use in a photolithography step in a process for producing an integrated circuit as well as pellicles used therein. In particular, as employed in a pellicle, the adhesive according to the present invention has a sufficient light resistance to ultraviolet rays of short wavelengths, requires no heating at the time of adhering and exhibits a sufficient adhesive strength. These properties are important in both the pellicle comprising an adhesive layer in which such an adhesive is used, and in the process for producing the pellicle. These properties are unexpected in view of the prior art.

Additionally, unexpected superior properties with respect to the specific ratios of polymer/monomer as recited in claims 10 and 11 are also achieved. For instance, if there is too much fluorine-containing monomer, the adhesive strength becomes too low. Conversely,

if there is too small an amount of fluorine-containing monomer, when the film is adhered, the spreadability of the adhesive becomes poor and it becomes difficult to adhere a film with good appearance. The Examiner is requested to refer to the 7th line from the bottom of page 7 to the first line of page 8 of the present specification in this regard.

In summary, Applicants respectfully submit that the Examiner has failed to present a valid *prima facie* case of obviousness. For instance, there exists no motivation in the prior art to arrive at the presently claimed subject matter. Moreover, even if the Examiner has hypothetically established a *prima facie* case of obviousness, a point not conceded by Applicants, the presently claimed invention achieves unexpectedly superior results. Thus, any hypothetical *prima facie* case of obviousness is moot.

In view of the above, Applicants respectfully submit that the present claims are allowable over the cited art. Accordingly, the Examiner is respectfully requested to withdraw all outstanding rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact the undersigned at the offices of Birch, Stewart, Kolasch & Birch, LLP at the number listed below.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three month extension of time for filing a reply in connection with the present application, and the required fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

for

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